

REMARKS

In the Official Action, the Examiner rejected claims 35, 37-39, 68, and 71-75. Reconsideration of the application in view of the remarks set forth below is respectfully requested.

Request for Interview with Examiner and Supervisor

As a preliminary matter, Applicants reiterate that it is the Applicants' understanding that the Examiner may not reopen prosecution after a final Board decision without approval of the Technology Center Director. Specifically, "[w]hen a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner *will not* be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title *without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.*" 37 C.F.R. § 1.198 (emphasis added). Because § 1.114 involves RCE procedures and § 41.50 involves requests for further action by the Board (e.g., remand), neither section applies to the present case. Furthermore, decisions regarding "[p]etitions or requests to . . . reinstate a rejection after decision by the Board of Patent Appeals and Interferences under 37 CFR 1.198, where no court action has been filed" are delegated to the Technology Center Director. MPEP 1002.02(c). Therefore, "[i]f the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution." MPEP 1214.04. In the present case, *the Examiner has not indicated that the TC Director has approved the actions taken by the Examiner subsequent to the Board's decision.* Accordingly, the Examiner's actions are not believed to be proper.

Further, Applicants stress that the Examiner appears to be unnecessarily prolonging prosecution. Applicants respectfully note that "[t]he goal of examination is to clearly articulate

any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” MPEP 706. Because the present divisional application was filed nearly six years ago and the Examiner has already issued *three* non-final office actions after appeal, any further rejections based on new grounds would not be made “early in the prosecution process.” Accordingly, Applicants respectfully remind the Examiner of the Examiner’s duties under 37 C.F.R. § 1.104. Specifically, the Examiner is required to “make a thorough investigation of the available prior art relating to the subject matter of the claimed invention.” 37 C.F.R. § 1.104(a). Additionally, if the Examiner rejects a claim for want of novelty or for obviousness, the Examiner “must cite the *best* reference at his or her command.” 37 C.F.R. § 1.104(c)(2) (emphasis added). Moreover, “the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.” MPEP 706. Therefore, if the Examiner withdraws the present rejections based on the following remarks, Applicants respectfully request allowance of all pending claims.

In the interest of providing clarification, Applicants presently submit arguments to overcome the Examiner’s rejections set forth in the Office Action. However, Applicants maintain that the Examiner does not appear to be operating with the approval of the TC Director, as is required by 37 C.F.R. § 1.198. In view of the language of 37 C.F.R. § 1.198 and the discussion set forth above, Applicants do not understand why the Examiner has continued to cite new references rather than allow the claims. It appears to be an inappropriate prolonging of prosecution without proper authority. Applicants would like to discuss these procedures with the Examiner because, as set forth above, Applicants believe them to be improper. Accordingly, if the Examiner maintains the rejection or otherwise does not provide an indication of allowance for the presently pending claims, Applicants hereby request an interview with the Examiner and the Examiner’s Supervisor to clarify the proper procedural course of action.

Objection to the Specification

In the Office Action, the Examiner contended that the title of the invention was not descriptive. The Applicants have amended the title to be clearly indicative of the invention to which the claims are directed.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 35, 37, 68, and 71-75 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0189257 (hereinafter the “Corisis reference”). Claims 38 and 39 were rejected as being unpatentable over Corisis in view of U.S. Patent No. 6,753,206 (hereinafter the “Huang reference”) and U.S. Publication No. 2003/0102567 (hereinafter the “Eskildsen reference”). Applicants respectfully traverse these rejections.

Applicants submit that the rejections cannot be maintained because the Corisis reference is unavailable as prior art in accordance with 35 U.S.C. § 103(c). The text of 35 U.S.C. § 103(c)(1) is set forth below:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Corisis reference and the present invention were assigned or under an obligation of common assignment to Micron Technology, Inc. at the time of the present invention. This is evidenced by the assignment recorded at Reel 012789 and Frame 0199, a copy of which is attached hereto as Exhibit A. Therefore, the rejections should be withdrawn because the Corisis reference qualifies as prior art only under 35 U.S.C. § 102(e), and the inventions were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, Micron Technology, Inc.

Specifically, the application for the Corisis reference was filed on April 8, 2002, and published on October 9, 2003. Further, as shown by Exhibit A, the subject matter of the Corisis reference was assigned to Micron Technology, Inc. The present divisional application was under an obligation of common assignment (i.e., under an obligation of assignment to Micron Technology, Inc.) at the time the claimed invention was made. Specifically, the parent of the present application, Application No. 10/141,447, was filed on May 8, 2002, and issued as U.S. Patent No. 6,682,955 on January 27, 2004. Because the present divisional application satisfied the requirements of 35 U.S.C. § 120, it is entitled to the benefit of the filing date of the parent application (i.e., May 8, 2002). Accordingly, the Corisis reference qualifies as prior art only under 35 U.S.C. § 102(e), and therefore is unavailable as prior art for the purposes of obviousness, in accordance with the exception made by 35 U.S.C. § 103(c).

In view of the fact that the Corisis reference is unavailable as prior art, the combinations set forth by the Examiner in rejecting all of the claims cannot support a *prima facie* case of obviousness. Applicants request reconsideration and allowance of all pending claims in their present form.

Conclusion

In view of the remarks set forth above, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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